Supreme Court of the United States.

OCTOBER TERM, A. D. 1899.

No. 149.

MAST, FOOS & COMPANY,
Petitioner,

vs.

STOVER MANUFACTURING COMPANY,
Respondent.

On Writ of Certiorari to the United States Circuit Court of Appeals for the Seventh Circuit.

BRIEF AND ARGUMENT FOR RESPONDENT.

Statement of the Case.

The petitioner, Mast, Foos & Company, filed its bill of complaint against the respondent, Stover Manufacturing Company, in the Circuit Court of the United States for the Northern District of Illinois, November 19, 1897, founded on letters patent of the United States No. 433,531, granted to the petitioner on the 15th day of August, 1890, upon the application of one Samuel W. Martin, for alleged Improvement in Windmills, alleging infringement by the respondent and praying an injunction and an accounting for profits and damages. The bill sets forth

that the petitioner, complainant below, had been, and was at the time of the filing of the bill, engaged extensively in the manufacture and sale of windmills embodying the improvements covered by said letters patent; acquiescense in the validity of the patent, except in the case of a small number out of the whole number of windmill manufacturers in the United States; and the sustainment of said patent by the Circuit Court of Appeals for the Eighth Circuit in the suit of *Mast, Foos & Co.* v. *The Dempster Mill Mfg. Co.*, commenced in the Circuit Court of the United States for the District of Nebraska. The bill also recited that the respondent participated in the management of the defence of said Dempster suit and had attached thereto as an exhibit the deposition of one C. B. Dempster, president of the defendant therein. A copy of the decision of the Circuit Court of Appeals for the Eighth Circuit and of the mandate were also attached as exhibits to the bill. The mandate directed the entry of an interlocutory decree and an accounting, and at the trial of this case it was admitted that no final decree had been entered in the Dempster suit. Three days after the bill in this case was filed, to wit, November 22, 1897, the complainant filed a motion for a preliminary injunction and gave notice that the same would be called up on November 29th. The petitioner, defendant below, having given a bond under the order of the court, the motion for preliminary injunction was postponed until the 6th day of December, 1897. Both parties filed numerous affidavits and the motion for preliminary injunction was finally submitted to the Circuit Court January 5, 1898. After full argument based on such affidavits and numerous exhibits, consisting mainly of letters patent of the United States and drawings or cuts of windmills and other devices older in the art than the patent sued on, the

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Circuit Court held the matter under advisement until January 31, 1898, when the court (Judge Grosscup) awarded an injunction and filed a written opinion, giving the grounds of such order. An appeal was taken from this order granting the preliminary injunction and the Court of Appeals, after full argument thereon, filed its opinion on the 26th day of July, 1898, finding the patent invalid, and that further proofs of a character to change the result were impossible, reversed the order below with directions to dismiss the bill for want of equity. Before the filing of the mandate in the Circuit Court application was made to this court for a writ of certiorari, and the writ was awarded October 25th, 1898.

The petition for the writ and the argument in support thereof, filed in this court, set out and rely upon two principal grounds, viz: *First*. That the Court of Appeals for the Seventh Circuit transcended its authority under the Act of March 3, 1891, and committed a grave error in ordering the bill dismissed for want of equity without any hearing other than a hearing on an interlocutory motion and without any evidence other than *ex parte* affidavits; and, *Second*. That the court erred in holding as a matter of law that the first claim of the Martin patent was void for want of invention, whereas it should have held, as did the Circuit Court of Appeals for the Eighth Circuit, that said claim was valid.

These two grounds are set forth in the petition and brief filed in support thereof as assignments of error in separate paragraphs or specifications, seven in number. The first six of these assignments relate to the alleged error in procedure and the seventh to the supposed error of law in deciding that the Martin patent was void.

BRIEF.

I. THE CIRCUIT COURT OF APPEALS FOR THE SEVENTH CIRCUIT ACTED WITHIN THE JURISDICTION, AUTHORITY AND DISCRETION CONFERRED UPON IT BY THE ACT OF MARCH 3, 1891, IN REVERSING THE INJUNCTIONAL ORDER APPEALED FROM AND IN DIRECTING THE BILL TO BE DISMISSED.

Smith v. *Vulcan Iron Works*, 165 U. S., 518.

In re Tampa Suburban Railroad Company, 168 U. S., 583.

Brown v. *Piper*, 91 U. S., 37.

Dunbar v. *Myers*, 94 U. S., 187.

Slawson v. *Railroad Company*, 107 U. S., 649.

Richards v. *Chase Elevator Co.*, 158 U. S., 299, and 159 U. S., 477.

Curtis v. *Overman Wheel Co.*, 58 Fed. Rep., 784.

Green v. *Mills*, 69 Fed. Rep., 852.

Mayor, etc. v. *Africa*, 77 Fed. Rep., 501.

Magic Light Co. v. *Economy Gas Lamp Co.*, 97 Fed. Rep., 87.

High on Injunctions, Vol. 2, 1277, Sec. 1706.

Rayle v. *Indianapolis, I. P. & C. R. R. Co.*, 40 Ind., 347.

II. THE COURT OF APPEALS FOR THE SEVENTH CIRCUIT WAS RIGHT ON THE RECORD MADE IN THAT COURT IN DECIDING THAT THE MARTIN PATENT WAS VOID FOR WANT OF INVENTION.

Potts v. *Creager*, 155 U. S., 597.

Wright v. *Yuengling*, 155 U. S., 47.

American Road Machine Co. v. *Pennock & Sharp Co.*, 164 U. S., 26.

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III. There was no variance between the Circuit Court of Appeals for the Seventh Circuit and the Circuit Court of Appeals for the Eighth Circuit in the application of the law, but simply a difference in result reached in the two cases, due to the different state of facts presented to said courts, respectively.

IV. Every fact necessary to the determination of the invalidity of the Martin patent either admitted or shown by undisputed records.

V. Respondent does not infringe, and the court below could have made the same order that it did make based upon non-infringement.

ARGUMENT.

We must assume that the writ in this case was granted, because this court desired to examine one or the other, or both, of the propositions, upon which the petition was based and what we shall say herein will be upon this assumption.

We shall affirm and contend:

First. *That the Circuit Court of Appeals for the Seventh Circuit acted within the jurisdiction, authority and discretion conferred upon it by the Act of March 3, 1891, in reversing the injunctional order appealed from and in directing the bill to be dismissed.*

Second. *That the Court of Appeals for the Seventh Circuit was right upon the record made in that court in deciding that the Martin patent is void for want of invention.*

We will now take up and present our views in support of both of the above propositions in the order as above stated:

As to the first proposition:

That the Circuit Court of Appeals for the Seventh Circuit acted within the jurisdiction, authority and discretion conferred upon it by the Act of March 3, 1891, in reversing the injunctional order appealed from, and in directing the bill to be dismissed.

We believe that there can be no ground of contention otherwise as to the truth of the statement that there is no substantial dispute or difference between the petitioner and respondent in these proceedings regarding the facts constituting the record.

There is, of course, a wide difference as to the contention and conclusion that is to be drawn respectively between the two parties litigant, based upon these facts, but there

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is no dispute as to the presence of these facts in this record, but only as to their effect. The existing condition that all the facts present in this case are represented by undisputed written documents, exhibits and affidavits, as to matters admitted, or uncontradicted, does not change the force or effect of such facts. Nothing would be added or taken away from such facts by setting forth and expressing them in deposition form. There was but one single question at issue in the courts below (Circuit and Appeal), namely, the validity of the patent and the question of infringement, such question being put at issue by motion for injunction by petitioner, the petitioner asserting that the patent was valid, and the defendant infringed, and demanding the injunction. At the Circuit the injunction was granted upon the assumption of the validity of the patent and the fact of infringement. In the Court of Appeals that court found that the patent was invalid and therefore the injunction could not stand, and that from the undisputed facts of the record, never could stand by reason of the invalidity of the patent, for want of patentable novelty upon the undisputed record; and therefore it followed that the bill itself must be dismissed, and so ordered.

We will endeavor to show, in discussing the second clause of our contention, that exactly the same order as to the dismissal of bill could well have been entered, and should have been entered, upon the admitted record, from the fact of non-infringement appearing therein, although this question was not passed upon by the Court of Appeals.

The question of the force and construction of letters patent for invention—unlike such question as usually determined from the face of the written instrument itself—is a question frequently, if not always, impossible to determine from the face of the patent itself, but must be

found out and ascertained by reason of, and in the light of, the existence and presence of the antecedent art, at least in the same industry; that is, the true construction of the patent can only be determined by reading into it, or reading it in connection with antecedent patents relating to the same subject-matter, or admitted analogous mechanisms in public use antecendent thereto. Of course if the patent upon its face recognizes, admits and states the old art correctly, then there is little need for confirmation or establishment of such condition by the introduction of the old antecedent patents; but when, as frequently happens, and as certainly happens in this case, the patent in suit does not correctly state or recognize the old art, then the antecedent patents themselves and facts as to antecedent mechanisms must be made part of the record and patent and the patent must be construed by reason of, and in the light of, the presence of these undisputed facts.

The position contended for is usually represented in the decisions of this court by such expressions as "In view of the state of the art, the claim must be limited," and "In view of this state of the art there was no patentable invention—nothing more than mechanical skill," etc. (*Tack Co.* v. *Mfg. Co.*, 109 U. S., 117; *Morris* v. *McMillin*, 112 U. S., 244; *Thompson* v. *Boisselier*, 114 U. S., 1; *Keyes* v. *Grant*, 118 U. S., 25; *Aron* v. *Manhattan Railway Co.*, 132 U. S., 84; *Pope Mfg. Co.* v. *Gormully & Jeffery Mfg. Co.*, 144 U. S., 238; *Lock Co.* v. *Lock Co.*, 150 U. S., 38; *Olin* v. *Timkin*, 155 U. S., 141; *Machine Co.* v. *Pennock*, 164 U. S., 26.)

Further, and as germane to this discussion, this court has frequently held that the question of the presence or absence of patentable novelty in an asserted patent is not always, even, a question to be determined by the court from the reading of the patent in the light of the antecedent

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art; but that the court can frequently determine this question from the face of the patent itself, and from a reading thereof, and do this even in a case where answer has been filed and full testimony taken. (*Brown* v. *Piper,* 91 U. S., 37; *Dunbar* v. *Myers,* 94 U. S., 187; *Lawson* v. *Railroad,* 107 U. S., 649; *Richards* v. *Chase Elevator Co.,* 158 U. S., 299, and 159 U. S., 477.) In the case of *Brown* v. *Piper, supra,* this court said:

> "Examined by the light of these considerations, we think this patent was void on its face, and that the court might have stopped short at that instrument, and without looking beyond it into the answer and testimony, *sua sponte,* if the objections were not taken by counsel, well have adjudged in favor of the defendant."

We respectfully contend that exactly the same conditions present in the above line of cases exist and are present in this case, and were so recognized by the Court of Appeals in the formulation of its opinion and the rendition of its decree. The finding of the Court of Appeals in this case is in direct line and in full harmony with the direct ruling of and the spirit and intention of the decisions of this Court, of the courts at several of the Federal Circuits and of the Supreme Courts in several of the states that have passed upon and discussed either the precise question presented or analogous questions.

The case of *Smith* v. *Vulcan Iron Works,* 165 U. S., 518, would seem to be conclusive upon the point that the Circuit Court of Appeals had jurisdiction and power, upon an appeal from an interlocutory decree, granting a temporary injunction, to direct a final decree dismissing the bill upon the record presented. In such case this court granted the petition for writ of certiorari for the special reason, as therein stated,

> "so that it may be determined whether, upon

an appeal from an interlocutory decree, granting a temporary injunction in a patent case, the Circuit Court of Appeals can render, or direct, a final decree on the merits."

The Circuit Court of Appeals in this last case took jurisdiction, and rendered its decision and decree under and by virtue of the provisions of Section 7 of the Act of 1891, and this Court, in speaking of this act and the question of jurisdiction of the Court of Appeals thereunder, as to interlocutory injunctions, states as follows in this last case:

> " The provision of Section 7 of the Act of 1891, that where 'upon a hearing in equity' in a Circuit Court, 'an injunction shall be granted, or continued by an interlocutory order or decree,' in a cause in which an appeal from a final decree might be taken to the Circuit Court of Appeals, 'an appeal may be taken from such interlocutory order, or decree, granting or continuing such injunction,' to that court, authorizes, according to its grammatical construction and natural meaning, an appeal to be taken from the whole of such interlocutory order or decree, and not from that part of it only which grants, or continues an injunction.
>
> " The manifest intent of this provision, read in the light of the previous practice in the courts of the United States, contrasted with the practice in courts of equity of the highest authority elsewhere, appears to this court to have been, not only to permit the defendant to obtain immediate relief from an injunction, the continuance of which throughout the progress of the cause might seriously affect his interests; but also to save both parties from the expense of further litigation, should the Appellate Court be of opinion that the plaintiff was not entitled to an injunction because his bill had no equity to support it."

The case *in re* Tampa Suburban Railroad Company, 168 U. S., 583, is a case where the writ of certiorari was asked for in this court upon a record below at the Circuit, made up entirely of pleadings and affidavits, an injunc-

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tion having been granted, no appeal having been taken to the United States Circuit Court of Appeals. The writ was denied in this case for that reason, the court saying, however:

> "But where the order also grants an injunction, the appeal provided for may be taken, and carries up the entire order, and the case may, indeed, on occasion, be considered and decided on its merits. (*Smith* v. *Vulcan Iron Works*, 165 U. S., 518.)"

The case of *Mayor, etc.* v. *Africa*, 77 Fed. Rep., 501, was a case pending in the United States Circuit Court of Appeals for the Sixth Circuit, upon appeal from the granting of an interlocutory injunction, based solely upon pleadings, affidavits and documents filed, the court saying:

> "Though this Court will not feel itself compelled to consider and decide such appeals upon the merits, yet it will do so when the circumstances seem to require it, and the record is sufficient. This practice has the high sanction of the court of appeals for the Fourth Circuit in the case of *Green* v. *Mills*, 16 C. C. A., 516, 69 Fed., 852, where the opinion was by Chief Justice Fuller. . . . . The injunction was improvidently granted. The case will be remanded, with direction to discharge the injunction, and dismiss the bill with all costs."

It appears in this case that there had been a misapprehension as to matters of fact, by the court, and for this reason a petition for rehearing was granted, modifying the above order of dismissal, but without changing the rule of law, under applicable conditions and facts, as above laid down by the court.

The case of *Curtis* v. *Overman Wheel Co.*, 58 Fed. Rep., 784, is a case closely analogous to the case at bar, and in which the Circuit Court of Appeals for the Second Circuit found the patent invalid upon the hearing of an

appeal from an order granting an interlocutory injunction, the defense record consisting solely of antecedent patents, the patent having before been sustained at the Circuit, upon final hearing, upon full record. We quote from that case, as showing the parallelism of facts between such case and the one at bar, as follows:

> "The full record and numerous exhibits presented by the defendant show that this description of the state of the art of pedal manufacture at the time of the patented invention is substantially complete, and cannot be amended, if it is understood that the pre-existing double fluted pedals were not merely arranged so as to be capable of turning, but were actually rotary, and free to turn. Pedals are shown in the English patent to Robert James Rae of September 11, 1878, which were double corrugated or fluted rollers, having their upper surfaces turned towards each other. The whole question of patentable invention is thus presented upon the face of the Overman patent, and is whether—single, polygonal, rotary bar pedals, and double, substantially round, but fluted, rotary bar pedals being old—it was the work of an inventor to substitute the wide working faces or the wide rectangular faces of the bars of the patent for the pre-existing round and fluted bars."

The court, after citing these facts, and giving its reasons, or argument, for the correctness of its conclusion, states as follows:

> "The vital question in this case is presented with approximate accuracy upon the face of the patent, and does not depend upon controverted questions of fact."

The case of *Magic Light Co.* v. *Economy Gas Lamp Co.*, 97 Fed. Rep., 87, "before Brown, Circuit Justice, and Woods and Jenkins, Circuit Judges," seems also to be conclusive in favor of the proposition here contended for. That was a case in which the court at the Circuit,

upon motion for interlocutory injunction, the record consisting entirely of patents, the file-wrapper and contents and affidavits, found the patent to be valid, the defendants to infringe, and granted the injunction. Upon an appeal therefrom, the Court of Appeals construed the patent narrowly, and found that such construction was necessary, from the file-wrapper and contents and the old art; and found that this record was conclusive, and dismissed the bill of complaint, the court concluding its opinion as follows:

> "These views seeming to exclude the possibility of evidence to sustain the charge of infringement, the decree below is reversed, and the action remanded, with directions to dismiss the bill."

The right of appeal from an order allowing an interlocutory injunction in the Federal Courts, or the refusal so to allow, is of such recent origin that the authorities are necessarily few as to the question at issue in the Federal Courts, by reason of this fact. As a matter of fact and practice, the injunction is practically the only relief sought by a bill in chancery, for the infringement of a patent. To be sure, the court having jurisdiction as to the matter of injunction can, if such injunction is granted, go on and find and assess damages and profits for the act complained of; but practically the cases are few where such ultimate proceedings are had, and certainly such proceedings never do follow and occur unless the complainant is entitled to the relief of injunction. In the case at bar, if the complainant is entitled to injunctional relief, he is entitled to an accounting for profits and damages. If he is not entitled to injunctional relief, he is not entitled to such accounting, and the bill should be dismissed. So, as a matter of fact, the question of the right of the complainant to injunction

is the vital and only relief sought by the bill of complaint. High on Injunctions, Vol. 2, page 1277, beginning paragraph 1706, therein discusses the general doctrine here asserted, with cited authorities, as follows:

> "In Illinois the doctrine is well established that in cases where an injunction is the only relief sought by the bill, and a motion to dissolve for want of equity in the bill is sustained by the court, the order of dissolution is such a final order as entitles the plaintiff to a writ of error, or an appeal therefrom. In such cases, the motion to dissolve operates as a demurrer to the bill for want of equity, and is considered as an admission of the material allegations of the bill. The decree, therefore, dissolving the injunction, is a complete denial of the equity of the bill, and of the relief sought, and the bill may be at once dismissed, and the action of the court reviewed on error or appeal. (*Titus* v. *Mabee*, 25 Ill., 257; *Shaw* v. *Hill*, 67 Ill., 455; *Weaver* v. *Poyer*, 70 Ill., 567. See also *Gardt* v. *Brown*, 113 Ill., 475.)"

The same text-writer makes no distinction between the hearing of a motion for injunction founded upon full record made, and upon the hearing of such motion founded upon bill, answer and affidavits, the author citing at the close of paragraph 1706, that:

> "The same rule is applied when the injunction is the only relief sought, and the motion to dissolve is heard upon bill, answer and affidavits; and in such case the dissolution of the injunction may be treated as a final disposition of the cause, from which an appeal will at once lie. *Prout* v. *Lomer*, 79 Ill., 331."

In the case of *Rayle* v. *Indianapolis, I. P. & C. R. R. Co.*, 40 Ind., 347., the court held in substance that on an appeal order relating to an interlocutory injunction it is error to dismiss bill, if it were open for a complainant to still show upon final hearing that he was entitled to a perpetual injunction.

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We cannot, however, conceive it to be possible, under any circumstances or conditions, that it can ever be made to appear by any record the complainant can make, that the patent in question is a valid patent, or that defendant infringes the same. The undisputed written instruments in this case, and the undisputed existence of the mechanical structures in the same industry, would seem to fix absolutely the fact of the invalidity of this patent, and the fact of defendant's non-infringement thereof, even if valid. It would seem that these are questions which no amount of testimony that can be taken by the complainant can alter or change.

We respectfully contend that it does not follow at all, as suggested by complainant's counsel, that if the Court of Appeals had the power and right to dismiss said bill of complaint upon the record here present, it also had the same power and right to find such patent valid, the defendant to infringe and order a final decree to this effect, with an order of reference to Master, accounting, etc. The record in this case shows that the injunction proceeding against this defendant was a drastic and rapid movement upon the part of complainant. No time was given defendant to file answer in this case, or to look up and collate defenses, except to the extent herein shown. It does not follow at all that upon further investigation, answer filed in this case and full proof taken, perfect defenses may not be had to this patent under any construction that may be put upon it, and a perfect defense exhibited, founded upon the fact of non-infringement.

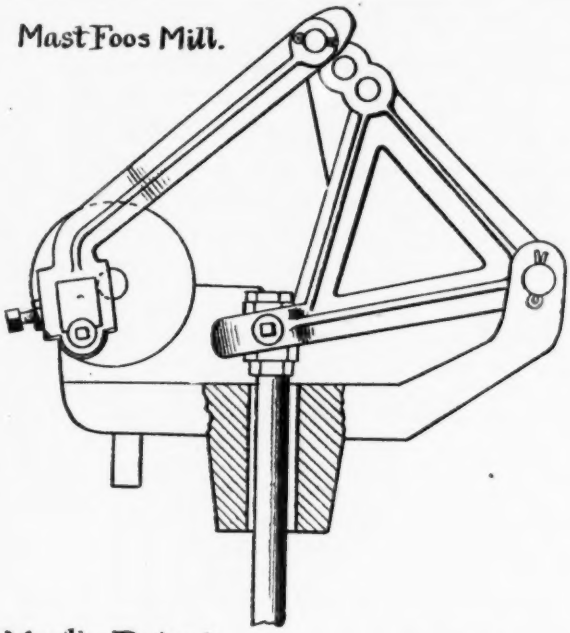
SECOND. *We contend that the Court of Appeals for the Seventh Circuit was right upon the record made in that court in deciding that the Martin patent is void for want of invention.*

The Martin patent is entitled for an "Improvement in Windmills," and, although it is described as applied to a windmill, the alleged *improvement* or *invention* is more properly described as a "mechanical movement," and unless it is patentable as a mechanical movement, it is not patentable at all. The statement of the invention is as follows:

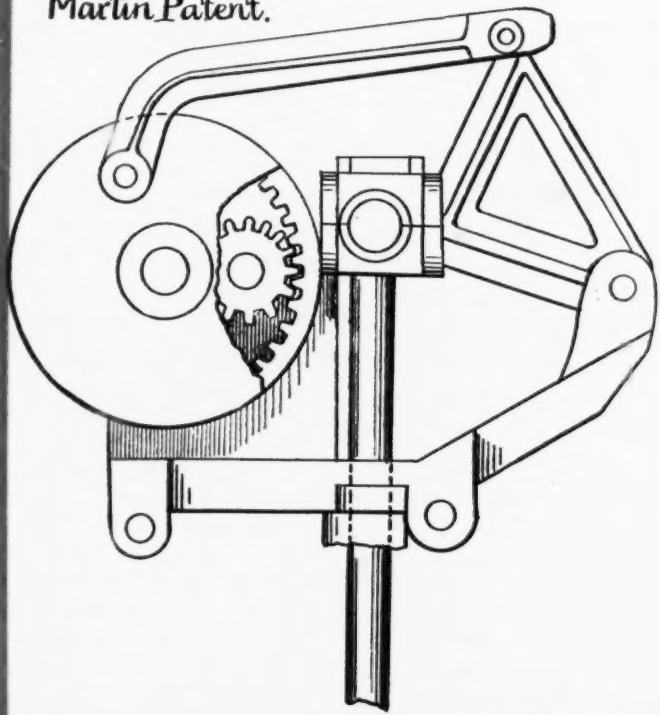
> "This invention consists, essentially, of an improved back-gear organization, involving an external-toothed pinion and an internal toothed spur gear, the pinion being mounted on the wheel shaft and the gear having formed on or connected with it the wrist pin, to which the operating pitman is attached, whereby the speed of the main shaft as applied to the wrist-pin and pitman is reduced, and whereby, also, all pounding and lost motion is prevented as the pitman connection passes over the center and changes from a pushing to a pulling action. This object is accomplished by the fact that a plurality of the pinion teeth are always engaged with the internal spur-gear, resulting in giving a perfectly uniform and smooth and noiseless reciprocating motion to the actuating rod, thereby prolonging the life of the machine by saving it from constant jarring and preventing wear and tear."

This statement of the invention discloses the fact that Martin conceived himself to be the inventor of a mechanical movement, wherein the rotary motion of a shaft was converted into a slow reciprocating motion of an actuating rod or pitman. He had two objects in view, *first*, to reduce the speed; and, *second*, to prevent pounding and lost motion. The first object he attained by mounting a small pinion on the power shaft, enmeshing it with a large gear; the second, by using an internal gear, that is, a gear with teeth on its perimeter instead of on its periphery, so that the internal gear encircled the pinion and engaged a

Mast Foos Mill.



Martin Patent.



greater number of its teeth than an external gear would engage.

That Martin conceived his invention to be broader in its scope than the application to a pump is obvious, notwithstanding the language of his claims and the title of his patent, from the fact that he states in his specification:

> "The actuating rod O connects with the pitman D in any approved manner at P and extends down from the tower to the appliance to be operated—say a pump."

The precise scope of Martin's invention will best be understood by a comparison of the accompanying cuts marked "Mast-Foos Mill" and "Martin Patent." Mast-Foos mill is the type of windmill which the patentee says had been previously on the market and manufactured by his assignees; and the problem before Martin was to gear that type of windmills. Instead of the internal gear of his patent, the Mast-Foos mill had a disk mounted directly on the shaft with the pitman-bar connected to a wrist-pin on this disk. What Martin did was to substitute an internal gear for the disk, mounting it on a separate stud, and apply the pinion N of his patent to the power-shaft L. He selected a well-known type of gearing, and the only one which could have been used in the machine to be geared. It is obvious that the cast-frame A and the bearing-block B were too narrow to mount external gears thereon. But without any change whatever in the frame-work of the machine, or at least by making a slight change in the bearing for the power shaft, the machine could be geared by using an internal gear.

An inspection of the cuts, therefore, shows that all that Martin did was to apply to this old type of windmill, hav-

ing the same peculiar triangular pitman, pitman-bar, wrist-pin and actuating rod, an internal gear and pinion.

If he had *invented* this internal gear and pinion and combined them with the other elements shown in the Mast-Foos mill, he might have justly claimed the title of inventor; but the prior art, as shown by patents and admittedly older devices, entirely negatives any such contention upon the part of Martin and stamps what he did as the work of an ordinary mechanic, involving only the application of common shop experience to the problem in hand.

Again, it may be that if this internal gear had not existed in *windmills* prior to Martin's invention, what he did could have been considered as an invention under the rule announced by this court in the case of *Potts* v. *Creager,* 155 U. S., 597; but the undisputed proofs in this case show that not only was the internal gear, or back gear organization of Martin's patent, well known in the mechanic arts, but also that it was well known in the windmill art and was to be found in windmills, not at arm's length, but at the precise point where Martin applied it.

NO VARIANCE OF OPINION BETWEEN COURTS OF APPEAL FOR SEVENTH AND EIGHTH CIRCUITS.

The supposed variance between the opinion of the Circuit Court of Appeals for the Eighth Circuit, in the Dempster case, and the decision of the Circuit Court of Appeals for the Seventh Circuit in this case, disappears when the records in the two cases are compared and considered. The record in the Dempster case was before the court in this case, and the prior art in the Dempster case is reproduced in this record under the title "Prior Art in Dempster

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Case." The patents relied on by the defendant in that case were as follows:

No. 49,021, July 25, 1865, to Charles Willard, for Improvement in Hay-Spreading Machines.

No. 182,394, of September 19, 1876, to Edward Williams, for Improvements in Windmills.

No. 191,708, of June 5, 1877, to T. J. Parrish, for Improvement in Churns.

No. 89,217, of April 20, 1869, to E. R. Hall, for Improvement in Wood-Sawing Machines.

No. 54,372, of May 1, 1866, to E. M. Krum, for Improvent in Harvesters.

No. 18,833, of December 8, 1857, to J. W. Brokaw, for Harvester Rake.

No. 398,466, of February 26, 1889, to Benjamin F. Stewart, for Grain Binder.

Only one of these patents related to a windmill, namely, that to Williams, and while the Williams patent showed a geared mill, it did not disclose an internally geared mill. Each of the other patents cited did disclose an internal gear of some form, and the Court of Appeals for the Eighth Circuit, as the case was presented to it, found a state of facts which brought the case squarely within the decision in *Potts* v. *Creager, supra.* The court says:

> "It is true that internal toothed spur-wheels have been familiar to mechanics time out of mind. They have been used on mowing machines and harvesting machines, on machines for sawing wood, and doubtless upon hundreds of other machines, but no one had ever combined one of these internal toothed wheels with the pinion, pitman and pump of a windmill until Martin made his invention in the year 1889. Windmills were old and their operation was familiar to mechanics, but until that year they went on pounding their wheels with every stroke of the pump rod, wearing themselves out prematurely and occasionally strip-

> their pinions of cogs, for the lack of the combination of this internal toothed-spur-wheel with the other essential elements of other machinery."

The court, in its opinion, then quotes from the decision of this court in *Potts* v. *Creager, supra*, the rule as to invention, where a transfer of an element is made from one art to another.

The Court of Appeals in the Seventh Circuit, in its opinion, says:

> "In the Eighth Circuit, the Court, accepting it as true that prior to Martin's invention all windmills had been driven by external gearings held that, though the like use of such gearings in other machines had long been familiar, the adaptation or transfer thereof to the windmill evinced invention. . . . But in view of the fact that in the windmill of Perkin's and in numerous others, on which patents had been granted before the date of Martin's application, external and internal gearings were in common use side by side, we find it impossible to credit with invention a patentee who did nothing but put one of the forms in the place of the other in a machine where both were already present, producing by the change no new result, but only improved effects or relative advantages long known to mechanics to be the result of using that form instead of the other. Such an exchange or substitution of one of two forms of gearing for another in a machine, where both are in familiar use side by side, is no more to be called invention than would be the substitution under like circumstances of one familiar make of pulley for another."

The court concludes its opinion with reference to *Potts* v. *Creager,* as follows:

> "The internal gearing, its effect, and its relative advantages over the other form had been familiar; it had been in use in windmills side by side with the external wheel, and if as employed in the Martin combination it served a use which in any sense was new, it was, in the language of the opinion in *Potts* v.

> *Creager* 'so nearly analogous to the former one that the applicability of the device to its new use would occur to a person of ordinary mechanical skill.' "

From these quotations it is obvious that there is no variance or divergence of view between the courts. Both cite and correctly apply the rules laid down by this court as to what shall constitute invention, and the opinions of both courts show them to be in complete harmony as to the law.

Had the facts been the same in the Dempster case as in the present case, there can be no doubt that the Court of Appeals for the Eighth Circuit would have found the invalidity of the patent for lack of invention.

In fact, the decision of the Court of Appeals for the Eighth Circuit is based not only upon the proposition that invention was required to transfer the internal gear from older machines and other arts to the windmill, but further upon the proof that Martin's invention had worked some sort of a revolution in the trade, and that the defendant in the Dempster case had practically copied its construction from the machines built by Mast, Foos & Co. under the Martin patent. Extensive adoption and use and copying of a patent and machine by the defendant charged with an infringement, are both important matters to be considered in deciding upon the validity of a doubtful patent, and evidence of this kind is often held sufficient to turn the scale.

The record in this case discloses a different state of facts, and even if the question of invention were still doubtful, the facts here present would tend to turn the scale against instead of in favor of the patentee.

THE FACTS INVOLVED IN THE DEMPSTER CASE.

From the opinion of the Court of Appeals and the printed copy of the transcript in the Dempster case, it appears that the following facts were admitted or uncontradicted in that case:

First. "All the witnesses on both sides of the case testified that the combination of the internal-toothed spur-wheel with the pinion and the other usual machinery of a windmill and pump is more useful and more valuable than any other combination of elements in a windmill and pump yet discovered."

Second. "The evidence of prior use is the testimony of a single witness, who was once in the employ of another infringer of the device of the appellant, but has since been employed by the appellee. He produces no part of the old windmill which he testifies was set up and put in operation before Martin filed his application, and his evidence is without the support of any patents or exhibits and without the support of any other witness."

Third. That prior to Martin's invention, "all windmills had been driven by the external-toothed spur-wheels," wherein "a pounding and racking of the machinery arose, which shortened its life and sometimes stripped the cogs from the pinion."

Fourth. That "the object of Martin's invention was to do away with this pounding and to prevent this wearing and strain of the machinery," and "the evidence is undisputed that this invention completely accomplished its purpose."

Fifth. That Martin's invention immediately went into general use and had displaced other devices previously employed for a similar purpose.

Sixth. That the only patent for a windmill offered as anticipating Martin's invention was No. 182,394, dated

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September 19, 1876, to Edward Williams, which showed two eccentric external-toothed gear-wheels, although the use of internal gears had been familiar to mechanics time out of mind and used on mowing machines, harvesting machines, machines for sawing wood, etc.

Seventh. That the defendants had adopted internal gear and discarded external gear in its windmills after seeing one of the complainant's internally-geared mills.

THE FACTS INVOLVED IN THE CASE.

In the present case the facts show:

First. That the use of internal instead of external gears is largely a matter of choice or convenience.

Second. That long prior to Martin's invention windmills had been on the market, which were driven in a variety of ways, including the use of internal gears, the extensive use of one form, known as the Perkins windmill, being clearly established in this record and, in fact, not disputed.

Third. That the alleged defects in externally-geared windmills were largely imaginary, and that there is no more wear and no greater tendency or liability to stripping the cogs in the one case than the other.

Fourth. That there is no greater tendency to pounding or racking in externally-geared mills, and that any defects of this kind are due solely to faulty construction or wrong proportions of the parts.

Fifth. That internally-geared windmills have not displaced externally-geared, the internally-geared now on the market being not over fifteen per cent. of the total output.

Sixth. That, whereas, in the Dempster case, only one windmill patent was set up in defense, and that contained external gears only, in the present suit some fifteen patents

of a date prior to Martin's invention are produced in evidence, each and every one of which discloses, associated with the driving mechanism of the windmill, some form of internal gear, in addition to which respondent exhibits scientific works on mechanics, drawings and descriptions, showing that the form of gearing was well known, and all of its functions and advantages fully understood long prior to Martin's invention. Besides this, the record contains a large number of prior patents for various sorts of machines showing the combination of driving-shaft, pinion, internal-toothed spur-wheel, pitman and actuating rod set forth in the first claim of the Martin patent, and arranged and operating in the same way to convert rotary into reciprocating motion.

Seventh. That instead of Martin's assignee being the pioneer in introducing the internally-geared windmill to the trade, the respondent first successfully introduced internally-geared windmills to the trade, such mills being of a radically different form of construction from that shown in the Martin patent, and such construction being substantially copied by Martin's assignees in the windmills afterward put out by them.

THE CHARACTER OF THE PROOFS IN THIS CASE.

One of the main grounds of complaint by the petitioner in this case is that the court has dismissed the bill upon *ex parte* affidavits and without proofs adduced in regular form. As we understand the decision of the court, its action is based entirely upon matters which are either of record or which are admitted, or at least not denied. In the statement preceding the opinion, the court gives a list of the devices taken from the older arts, which were urged by the defendant below. These prior devices were all rep-

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resented by letters patent, with the exception of "Mast-Foos Mill" and "Perkins Mill," and the book entitled "507 Mechanical Movements," published in 1871. The existence of these three devices is abundantly established by the record, and if not admitted in terms, was not denied, and there was no controversy as to the precise character and effect of each and every one of them. The sketch entitled "Mast-Foos Mill" was made from an actual mill produced by the complainant (petitioner here), at the trial of the case before the Court of Appeals for the Eighth Circuit. One of the counsel for the petitioner made an affidavit in this case, which is contained in the Record, on pages 50 and 51, and which contains the following reference to this exhibit:

> "I further say that in the trial of *Mast, Foos & Co.* v. *Dempster Mill Mfg. Co.*, in the court of appeals at St. Louis, there was presented to the court the mill now brought into this court by the defendant, and marked 'Defendant's Exhibit Mast-Foos Mill.' This identical mill was shown and explained to the Judges in the course of the arguments, both by Judge L. L. Morrison and by myself. It was not before the court as an exhibit that had been regularly offered, but was brought in by the defendant and unobjected to by me, as I knew it was a correct representation of one of the old-time windmills made by Mast, Foos & Co. It was used before the court by Judge Morrison to show the pitman arrangement used by Mast, Foos & Co., before the Martin patent was obtained and was used by myself to show the court the advancement and improvement made by the Martin patent over this previous type of mill."

This is the mill which was undoubtedly referred to in the specification of the Martin patent in lines 43-46, as follows: "This pitman is triangular and of the type on the market in windmills manufactured by my assignees of this invention."

The Perkins mill is equally well established, and there was no controversy that it preceded the Martin patent and was extensively used. On behalf of the respondent there was presented the affidavits of Manuel M. Fisher, Record, 53-55; James A. Becher, Ib., 56; Edward G. Heiner, Ib., 57; Adolph Rotterman, Ib., 58, and James A. Simonton, Ib., 59, all of whom were connected with the manufacture of these mills; and the affidavits of Robert Doyle, Record, 65, who purchased one of them in September, 1885, and used it on his farm until November 1890; and of William D. Burkett, who saw the Doyle mill in use. (Ib., 67.) The petitioner also read in evidence an affidavit by Manuel M. Fisher (Record, 64), in which it is again stated that the Perkins Windmill & Ax Company began to sell these internal-geared mills in 1884, and the affiant attached a cut which is the same as that shown opposite pages 66 and 92 of this Record. Judge Grosscup says, in his opinion (Record, 78): "The device principally relied upon to show prior use is that of the Perkins mill, manufactured at Mishawaka, Indiana. It is not disputed that this mill, in fact, antedates the Martin device; the inquiry simply is whether it, in the sense of the patent law, anticipates the Martin device."

The little book entitled "507 Mechanical Movements" is a hand-book, which was first published about the year 1871, and which has been extensively used ever since by engineers, draftsmen and designers. It is found in the principal public libraries, and in the office of nearly every patent lawyer and prominent solicitor in the country, and neither its date of publication nor its general circulation and use was denied by the petitioner. The cut taken therefrom is not reproduced in the printed record, but it is shown on respondent's drawing exhibits, and the de-

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scriptive matter is quoted in the statement preceding the opinion of the Court of Appeals in this case.

The other facts alluded to by the Court of Appeals, in its opinon in this case, are fully established by the affidavits in the case, and the most important ones are not denied. These facts are that the Martin invention had been adopted only to a very limited extent, and that the devices of the Martin patent and the supposed defects of external gearing had been exaggerated in the Dempster case. The evidence as to these two matters, it is true, are contained in *ex parte* affidavits, and mainly in the affidavits of Willis A. Merrifield (Record, 34) and of Oscar J. Ziegler. (Ib., 46.) The petitioner filed many affidavits after the respondent's affidavits above mentioned were filed, but in none of them are the statements relating to the limited use of internally-geared windmills, and the defects of externally-geared windmills contained in the respondent's affidavits denied, although one of said affidavits was made by the patentee himself. (See affidavit of Samuel W. Martin, Record, 73.) If the respondent's allegations could not be denied, even by testimony of like character, viz., *ex parte* affidavits, it would seem that the petitioner could hardly expect to refute them by proofs.

Upon the whole, therefore, it will be seen that the decision of the court below was based upon matters of record, facts which were admitted and conditions which were asserted and not denied.

That the decision of the court in the Seventh Circuit on the undisputed facts was right we think is beyond question.

All that Martin did was to apply an internal gear wheel previously used in windmills to a known type of mill. If any invention was required to do this, it must be found in the adaptation to the peculiar style of mill shown in his patent which the respondent does not use.

The advantages of internal gears were well known and had been used not only in windmills but in various machines where the same problems of racking and pounding and the change from a pulling to a pushing strain were present. The advantage arising from the engagement of a larger number of teeth was ever present in internal gears. Martin made no discovery in this regard. The "back gear" organization was merely the selection of gears of such proportion as would produce movements at the desired speed or velocity, a problem which would not puzzle anyone, because the rules for calculating gearing are as simple as the multiplication table and equally well known to all users of machinery.

Martin therefore discovered no new function, no advantage, and he created no new situation except in the limited sense that he first applied an internal gear to the old "Mast-Foos" mill with its triangular pitman.

This court has frequently denied the title of inventor to improvers in the mechanic arts where alleged inventions, like Martin's, improved the particular device to which they were applied only in the narrow sense of carrying forward an old idea.

Thus in *American Road Machine Company* v. *Pennock & Sharp Co.*, 164 U. S., 26, the substitution of a heavier wheel whereby the increased momentum carried the wheel along sufficiently to enable the operator to take a new grasp without clamping the wheel to prevent its running backward was held not to be the product of a creative mental conception but merely the result of the exercise of the ordinary faculties of reasoning upon the materials supplied by a special knowledge and the facility of manipulation which results from its habitual and intelligent practice.

The following language from that opinion (*vide* page 41) applies *mutatis mutandis* to the case at bar:

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> "It appears to us that, it being seen that the tendency to reverse would prove objectionable in the proposed machine, the suggestion that the hand-wheels should be made heavier in order, by greater momentum, to correct that tendency, as it was well known increase in weight coupled with adequate rotative force would, sprang naturally from the expected skill of the maker's calling, and that this use of the heavier wheel did not make the mechanism in any proper sense a new thing evolved by the inventive faculty."

The case of *Wright* v. *Yuengling*, 155 U. S., 47, is also directly parallel, as shown by the following quotation from page 53 of the report:

> "Wright's only invention, then, was in the combination of the cylindrical guide with the trough shown in the Farrar patent. Did this accomplish a new and valuable result it is quite possible that a patent therefor might have been sustained, but we do not find this to be the case. The cylindrical guide performs the same functions as in the prior patents; the trough, in which the connecting rod works in the Farrar patent, is practically the same as in the Wright patent, and the combination is a mere aggregation of their respective functions. If the combination of the trough and cylindrical guide of the Wright patent gives greater lightness and strength to the frame than the combination of the trough and the flat guides of the Farrar patent, it is a mere difference in degree, a carrying forward of an old idea, a result, perhaps, somewhat more perfect than had theretofore been attained, but not rising to the dignity of invention. We have repeatedly held patents of this description to be invalid. *Stimpson* v. *Woodman*, 10 Wall., 117; *Smith* v. *Nichols*, 21 Wall., 112; *Guidet* v. *Brooklyn*, 105 U. S., 550; *Hall* v. *Macneale*, 107 U. S., 90."

We therefore reiterate that no proof would be possible to change the results of the record evidence which clearly establishes in this case the common use of internal gears in windmills, which fact, absent from the Dempster case and

present here, constitutes the foundation for the different conclusions reached by the Courts of Appeal in the Seventh and Eighth Circuits, respectively.

RESPONDENT DOES NOT INFRINGE.

The decision of the court below did not touch the question of infringement, although that question was presented to the court both in the oral argument and in the briefs. Neither was there an attempt, in the opinion of the court, to construe the first claim of the patent beyond the ascertainment of the essential feature of the claim. The language of the opinion in regard to the construction of this claim is as follows:

> "In respect to the merits: It was stated in the opinion of the court in the Dempster case, and we think correctly, that 'the essential element' of the first claim of the patent was 'the internal toothed spur-wheel or spur-gear meshing with and driving the pinion which actuated the pitman and pump-rod;' and at the same time it was conceded to be 'true that internal toothed spur-wheels, their effect, and their relative advantages over external toothed wheels had been familiar to mechanics time out of mind.'"

Our contention is that even if the Martin patent can be sustained at all, it must, in view of the prior art, be limited to the precise and specific construction of parts shown and described in the drawings and specifications and particularly enumerated in the claim of the patent, and that as thus limited it is not infringed.

If the patent be limited strictly to a windmill, as contended by the petitioner in this case, and if, as the specification indicates, Martin's improvement was upon a particular kind of windmill previously well known in the art and he has chosen to limit his claim to this particular combina-

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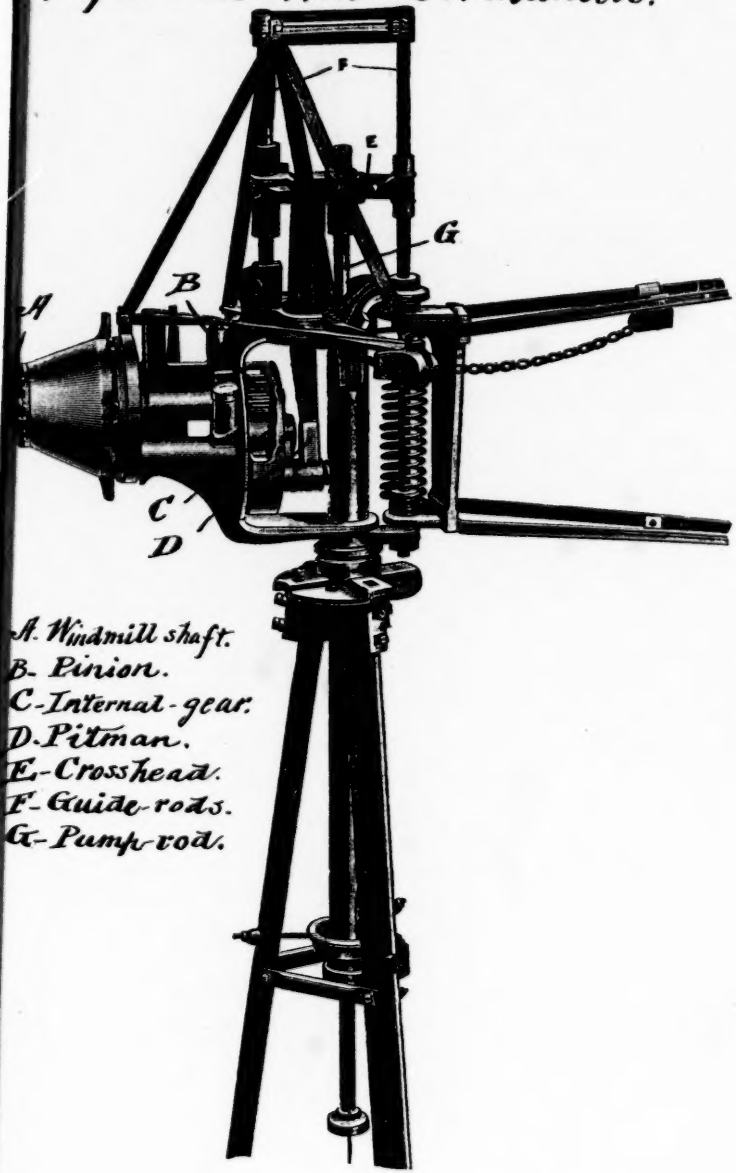
Defendant Appellant's Windmill.



A. Windmill shaft.
B. Pinion.
C. Internal-gear.
D. Pitman.
E. Crosshead.
F. Guide-rods.
G. Pump-rod.

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tion of devices; then the respondent does not infringe upon said claim.

We present herewith a cut or drawing of petitioner's windmill with a legend which will make the construction plain.

The Circuit Court in granting the injunction in this case said, speaking in relation of the Dempster case:

> "The patent was before the United States Circuit Court of Appeals for the Eighth Circuit, where its validity was affirmed and a device almost precisely like that of the defendant in this case was held to be an infringement. The majority of the court held that the invention consists in the combination of an internal toothed spur gear with any suitable pinion, wind-shaft, wrist-pin, pitman and pump-rod of a windmill. Within the ruling in that case, relating to the scope of the patent, the device of the defendant in the case under consideration is clearly an infringement."

This language fairly states the construction placed upon the patent by the majority opinion of the Court of Appeals in the Dempster case. Judge Thayer, in the dissenting opinion, said:

> "In my judgment, the combination covered by the first claim of Martin's patent, No. 433,531, is destitute of patentable novelty unless the word 'pitman,' as used in that claim, is understood to include the triangular pitman mentioned in the specification, as well as the pitman, E, which is termed in the specification the 'pitman-bar.' If the claim is construed as covering both of these parts, which together operate as a pitman, it might be upheld; but in that event the defendant would not be guilty of infringement, because he does not use the triangular pitman, or any equivalent device. The majority of the court have construed the word 'pitman' as meaning simply the 'pitman-bar,' which is immediately attached to the spur-wheel, and as thus construed, it admits of no doubt that the exact

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> combination covered by the first claim is disclosed by a multitude of machines, such as mowers, reapers, churns, machines for sawing wood and others of a similar character." 82 Fed. Rep., 327, 335.

This language applies exactly to defendant's construction in the present case.

The proof of infringement submitted by the petitioner in this case consisted of a single sentence in the affidavit of W. H. Rayner attached to the bill and found in the record at page 16, as follows:

> "I have compared the first claim of said letters patent with this Stover internal-geared windmill and with the cut attached, and I have found in such windmills and in such cut the mechanism specified in said claims, arranged in the same or substantially the same way, and performing the same work by the same mode of operation."

Mr. Rayner is the manager of Mast, Foos & Company, the petitioner herein, and does not pretend to have any particular familiarity with patents or any special qualification for testifying as an expert in patent causes.

On behalf of the respondent there were filed the affidavits of two mechanical experts of well known high standing, Mr. Irvine Miller and Mr. Robert H. Wiles. Mr. Miller's affidavit is printed at pages 21-32 of the Record, where Mr. Miller says, in speaking of claim 1:

> "I understand that the elements of this claim are as follows:
>
> "1. A shaft, meaning the wind-wheel shaft L of the patent.
>
> "2. A pinion thereon, meaning thereby the pinion M of the patent.
>
> "3. An internal-toothed spur-wheel, meaning thereby the gear G of the patent.
>
> "4. A pitman connected with the spur-wheel, meaning thereby the pitman D of the patent.

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" 5. An actuating-rod connected with the pitman, meaning thereby the rod O of the patent.

" As to the fourth element of this claim, to-wit, the pitman, I am of the opinion that the patentee intends to indicate and does indicate the part marked D in the drawings of the patent, chiefly for the reason that throughout the specification and claims of the patent the word 'pitman' is used solely for the purpose of designating this one part, that the term is applied to the said part and to no other part, and that whenever and wherever the part marked E in the drawings is referred to it is designated as the 'pitman-bar.'

" I am further confirmed in my understanding that, by the term 'pitman' as employed in claim, only the part marked D in the drawings is indicated and not the part marked E, by a comparison of claim one of the patent with claim two thereof.

" Claim 2 reads as follows:

" ' 2. The combination, with a wind mill driving-shaft and a pinion mounted thereon, of an internal toothed spur-wheel mounted adjacent to said shaft and meshing with said pinion, a pitman-bar connected to the spur-wheel, a pivoted pitman connected to the said bar, and an actuating rod connected to said pitman.'

" It will be observed that this second claim differs from the first claim in having therein, as an additional element, the pitman bar. It will also be observed that, in the statement of invention already quoted by me, the patentee states that 'the gear has formed on or connected with it the wrist-pin to which the operating pitman is attached.' By this language I understand that the patentee in his first claim does not wish to limit himself, in so far as the connection between the pitman D and the gear-wheel G is concerned, to the specific connection by means of a pitman-bar shown in the drawings and described in the specification, but that he desires it understood that any suitable connection between the pitman-bar D and the gear G will be within the scope of his first claim in so far as this element of the combination is concerned

" In the second claim however, I understand that

> he desires to limit the combination, as to this feature thereof, to a connection which is established between the triangular pitman D and the gear G by means of a pitman-bar E."

Mr. Wiles in his affidavit, Record, 38 *et seq.*, states fully and clearly reasons appearing from the face of the patent itself why the first claim thereof cannot be held to cover the defendant's construction.

Upon the question of infringement we contend that the facts in evidence require such a limited construction of Martin's first claim, even if the same could be held to be valid, as to relieve respondent from the charge of infringement, and unless infringement is clear the injunction could not have been granted, and upon this contention we submit the following propositions:

First. Martin set out to improve a particular style or make of windmill, viz., "Defendant's Exhibit Mast-Foos Mill." The problem he undertook was to apply a back-gear to this mill having the peculiar triangular pitman D, pitman-bar E and actuating-rod. Defendant's structure does not have this triangular pitman and pitman-bar.

Second. The language of the specification neither suggests nor describes any other form of pitman save the particular triangular pitman shown. The specification of the patent says, lines 43-46:

> "This pitman is triangular and of the type on the market in windmills manufactured by my assignees of this invention."

There is no reservation as to the form of the pitman, and the fact that Martin understood the importance of such reservation and the suggestion of modifications is shown by the language of his specification with reference to other

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parts of the device; for example, in speaking of the internal gear, his specification says, lines 50-51:

> "This gear may be of any approved type so long as it is provided with internal teeth."

Third. Unless Martin's patent be limited to his particular type or style of windmill it is clearly met in the older art.

CONCLUSION.

In conclusion, we submit that the Court of Appeals had *authority* under the law and upon the record as presented to make the order directing the bill to be dismissed; that the court *rightly* ordered the bill to be dismissed on the ground that the patent is void for want of invention; and that the court could as properly have directed the dismissal of the bill on the ground that the patent must be narrowly construed and when so construed was not infringed.

Respectfully submitted,

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CHARLES C. LINTHICUM.
Counsel for Respondent.

LOREN L. MORRISON.
Of Counsel.

January, 1900.